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Supreme Court of the United States

OCTOBER TERM, 1929.

No. [redacted] 19

LEKTOPHONE CORPORATION,
Petitioner,

vs.

THE ROLA COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE NINTH CIRCUIT, BRIEF IN SUPPORT THEREOF and APPENDIX.

CHARLES E. HUGHES,
WILLIAM H. DAVIS,
Counsel for Petitioner.

GALLO & ACKERMAN, Inc., 142 Liberty Street, 'Phones—Hitchcock 3078-9.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1929.

LEKTOPHONE CORPORATION,

Petitioner,

vs.

THE ROLA COMPANY,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE NINTH CIRCUIT.

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, Lektophone Corporation, respectfully prays for a writ of certiorari to the United States Circuit Court of Appeals for the Ninth Circuit to review the decision of that Court in the above entitled case filed September 23, 1929 (34 Fed. [2d], 764; and R., 172).

Grounds for Petition.

A conflict as to the scope of patent claims, on substantially the same evidence of prior art and substantially the same type of accused device, exists between the Court of Appeals for the Ninth Circuit and the Court of Appeals for the Third Circuit.

The patent is No. 1,271,529, granted July 2, 1918, to Hopkins for an "Acoustic Device."

The patented acoustic device is a direct-acting, cone-type loudspeaker for phonographs and radio sets. Li-

censed, and also alleged infringing loudspeakers have been and are being manufactured and sold in large quantities in every judicial circuit in the United States.* Although some of the licensees have bought paid-up licenses, most of them are operating on a continuing royalty basis. The patent has been much litgated in this country and the corresponding patent has been much litigated abroad. The opinions of the courts in this country and abroad have been printed in a pamphlet entitled "Lektophone Litigation—Opinions and Decrees," which we have filed with the transcript of record herein. A list of the cases is printed at the end of this petition. The state of uncertainty in which the manufacturers now find themselves can be corrected only by a ruling of this Court.

The Subject Matter Patented.

The acoustic device of the patent is a mechanical combination of three elements—(1) a large paper cone which is vibrated at sound frequencies to impress sound waves directly on the air; (2) a rigid annular supporting frame, and (3) a yielding rim flexibly connecting the vibrating cone to the rigid frame.

The Court of Appeals for the Third Circuit in the *Brandes case*, 20 Fed. (2d), 155, with full knowledge of the prior art that was later considered by the Court of Appeals for the Ninth Circuit in the instant case, held the patent valid and infringed. For the convenience of this Court, the opinion in that case is printed as an appendix to the brief submitted herewith. Judge Buffington, speaking for the Court of Appeals for the Third Circuit, said (appendix, p. 13):

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*Plaintiff's witness, Farrand, estimated that approximately 1,250,000 licensed speakers had been sold at the date of the Rola trial (May 10, 1928). Of these, approximately 675,000 were sold by licensees reporting and paying continuing royalties, and the Radio Corporation had sold a quantity estimated at 500,000 (R., 127-129).

> "To our minds, Hopkins was the first to make the combination of a conical-shaped paper device of proper size, provided with flexible edges, coupled to a rigid frame, used in free air. All of these three elements in free air, the light conical sounding-board of specified area, the flexible edge, and the rigid frame, combine to produce pure low notes. The device has come into general use, and its licensees are now supplying the public needs."

The Court of Appeals for the Ninth Circuit in the instant case, found it "unnecessary to pass upon the validity of the patent" (R., 200), but held (R., 202-3) the patent not infringed.

The Issues As to Which the Conflict Exists.

In the specific embodiment of the invention illustrated in the patent drawing (Ex. Bk., 2), the yielding rim is a flat plane peripheral extension of the paper cone.

The conflict lies in a difference of opinion of the two courts as to what is an equivalent for this flat (plane peripheral) rim extension of the paper cone.

1. The Court of Appeals for the Third Circuit in the *Brandes case* held the patent infringed by the Brandes loudspeaker, in which the yielding rim was thin, slack rubber (Appendix, p. 16), substituted for the paper rim of the specific embodiment of the patent.

The Court of Appeals for the Ninth Circuit in the instant case held the patent not infringed by defendant's loudspeaker, in which the yielding rim is "soft kid leather" (R., 175), substituted for the paper rim of the specific embodiment of the patent.

That Court expressly disagreed with the Court of Appeals for the Third Circuit, saying (R., 201): .

> "• • • we cannot follow the latter decision in so far as it holds that a flexible, non-resonant rim or annulus connecting the cone of the diaphragm to the stationary metal rim is the equivalent in a sound reproducing device of the flat rim or plane annulus of Hopkins' tympanum • • •."

2. There was a subordinate issue presented to both courts on which they likewise differed.

The patent, after pointing out (Ex. Bk., 4, lines 72, et seq.) that the tympanum consists of—

> "an annular plane peripheral portion or supporting rim *l*, the outer edge of which is tightly-gripped and rigidly supported between the rings K,K', and a central conical portion *l'* rising from the inner edge of the said rim *l*."

Adds that—

> "If satisfactory regeneration of sounds from a record or other sound vibrated element is to be had, the whole diameter of the tympanum, that is, the diameter of the aperture in the rings K,K' should exceed nine inches in order that the conditions required to regenerate the sound waves in the manner above described shall be fulfilled. The base of the central conical portion *l'* should exceed in area one-half of the effective area of the entire tympanum, that is, the area of the aperture in the rings K,K'; or in other words, the diameter of the base of the said conical portion should be at least eight-tenths of the diameter of the said aperture."

The specification goes on to say (same page, lines 77, et seq.):

"It is, of course, possible to make some variation from the approximate sizes given without materially altering the result; * * *" etc.

Claims 1, 2, 3, 5, 6 and 7 (Ex. Bk., 5) are expressly limited to a tympanum (cone plus yielding rim) "exceeding nine inches in diameter." The size of the cone is defined in these claims as "not less than eight-tenths of the diameter" of the tympanum. Claims 4 and 8 are not limited to those specific dimensions. They specify a tympanum (claim 4) or a conical portion (claim 8) "of sufficient area to produce self-sustaining sound waves in the surrounding air when vibrated."

In the *Brandes case* there were two forms of the defendant's loudspeaker, a larger one and a smaller one. Both were held to infringe. The larger one had a tympanum whose overall diameter exceeded nine inches. The smaller one had a tympanum whose overall diameter was slightly less than nine inches—eight and seven-eighths inches. But the diameter of the conical portion was greater than eight-tenths of nine inches, thereby retaining the large cone area of the patent. The reduction in overall diameter of the tympanum of the smaller form was achieved without encroaching upon the size of the cone by making the thin slack rubber rim narrower than the flat rim extension of the paper cone of the patent.

In the instant case the loudspeaker is of substantially the same size as the smaller Brandes loudspeaker. The diameter of the base of the conical portion exceeds eight-tenths of nine inches, thus retaining the large cone area, but the overall diameter of the tympanum (cone plus yielding rim) is slightly less than nine inches—eight and seven-sixteenths inches (Ex. Bk., 23). Here, too, this is achieved without encroaching upon the size of the cone by making the soft leather rim narrower than the flat rim extension of the paper cone of the patent. This

was held not to infringe, and in that holding, the smaller size, as well as the change in the material of the rim, was taken into account. The Court of Appeals for the Ninth Circuit said (R., 202-3):

> "We must either hold that the appellant's device is void for lack of invention or that he is so narrowly confined by the specified dimensions and claims of his patent that the smaller device of the appellee, with its limp leather annulus, does not infringe. It is sufficient for the purpose of this case to follow the latter course, as the trial Judge did."

WHEREFORE, your petitioner respectfully prays that a writ of certiorari be issued under the seal of this Court, directed to the United States Circuit Court of Appeals for the Ninth Circuit, commanding that court to certify and send to this Court on a day to be designated, a full and complete transcript of the record and all proceedings in the case entitled and numbered Lektophone Corporation, Appellant, vs. The Rola Company, Appellee, No. 5,712, to the end that this cause may be reviewed and determined by this Court; that the decree of the Circuit Court of Appeals for the Ninth Circuit be reversed, and that petitioner be granted such other and further relief as may seem proper.

LEKTOPHONE CORPORATION,
By

CHARLES E. HUGHES,
WILLIAM H. DAVIS,
Counsel for Petitioner.

Dated, New York City, December 14, 1929.

United States Litigation.

Lektophone Litigation Pamphlet

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BRIEF IN SUPPORT OF PETITION.

In view of the conflict of authority between the Courts of Appeals for the Third and Ninth Circuits, it does not seem necessary to make any extended argument in support of this application.

The difference of opinion turns upon the scope of the patent claims, interpreted in the light of the prior art and of the patent specification. The question of infringement resolves itself into one of law depending upon a comparison between the structure disclosed on the face of the patent and the device manufactured and sold by defendant, and the correct application thereto of the rule of equivalency (*Sanitary, etc., Co.* vs. *Winters*, decided Oct. 14, 1929, at p. 4).

In the past ten years this Court has issued writs of certiorari to bring up the following patent cases, in which the conflict of authority turned upon the *scope* of patents held valid by both of the lower courts. *Bone* vs. *Marion County*, 251 U. S., 134; *Weber, etc., Co.* vs. *Freeman, etc., Co.*, 256 U. S., 668; *Hildredth* vs. *Mastoras*, 257 U. S., 27; *I. T. S., etc., Co.* vs. *Essex, etc., Co.*, 272 U. S., 429; *Temco, etc., Co.* vs. *Apco, etc.*, 275 U. S., 319; *Holland, etc., Co.* vs. *Perkins, etc., Co.*, 277 U. S., 245; and *Sanitary, etc., Co.* vs. *Winters and Winters* vs. *Dent, etc., Co.*, decided October 14, 1929.

In some of these cases the alleged infringing devices in the two Circuits have been substantially the same, as they are in the instant case (*Bone* vs. *Marion County; Hildreth* vs. *Mastoras; I. T. S., etc., Co.* vs. *Essex, etc., Co.; Temco, etc., Co.* vs. *Apco, etc., Co.; Holland, etc., Co.* vs. *Perkins, etc., Co.;* and *Sanitary, etc., Co.* vs. *Winters* and *Winters* vs. *Dent*). In other cases, the alleged infringing devices have been very different (*Weber, etc., Co.* vs. *Freeman, etc.*, 256 U. S., 668 at p. 679).

In many of the cases, as in the instant case, the evidence of prior art was substantially the same in the two Cir-

cuits* (*Weber, etc., Co.* vs. *Freeman, etc., Co.*; *Hildreth* vs. *Mastoras*; *I. T. S., etc., Co.* vs. *Essex, etc., Co.*; *Temco, etc., Co.* vs. *Apco, etc., Co.*; *Holland, etc., Co.* vs. *Perkins, etc., Co.*; and *Sanitary, etc.*, vs. *Winters*). In other cases, the evidence of prior art in the two Circuits has been quite different (see *Bone* vs. *Marion County*, 251 U. S., 134, at p. 140).

The instant case, therefore, presents a direct conflict on a question of law between the Circuit Court of Appeals for the Ninth Circuit and the Circuit Court of Appeals for the Third Circuit. That conflict affects very substantial industrial interests. It cannot be resolved otherwise than by a decision of this Court.

Respectfully submitted,

CHARLES E. HUGHES,
WILLIAM H. DAVIS,
Counsel for Petitioner.

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*The prior patents and publications discussed in the opinion of the Court of Appeals for the Ninth Circuit are: The Starling & Cole publication (R., 176), Lumiere patent (R., 186), Dann & Lapp patent (R., 189), Maxwell patent (R., 189), Rogers patent (R., 190), and the British patent to Brown (R., 191). The Court of Appeals for the Third Circuit discussed Starling & Cole (*post*, p. 13) and Lumiere (*post*, p. 14), and the British patent to Brown is one of the "metallic sounding diaphragms used in confined space," referred to by that Court (*post*, p. 13). The Maxwell and Rogers patents had been before the courts in the earlier *Sylo case*. They had been pleaded but not proved in the *Western Electric case*. The Dann & Lapp patent, brought into the instant case not as an anticipation but as part of the prior art (R., 68-69), was not before the Circuit Court of Appeals for the Third Circuit and had not been before any other court in the earlier litigation.

APPENDIX.

IN THE

UNITED STATES CIRCUIT COURT OF APPEALS,

FOR THE THIRD CIRCUIT.

No. 3603. March Term, 1927.

LEKTOPHONE CORPORATION,
Plaintiff below, Appellant,

vs.

BRANDES PRODUCTS CORPORATION,
Defendant below, Appellee.

APPEAL FROM THE DISTRICT COURT OF THE UNITED STATES FOR THE DISTRICT OF NEW JERSEY.

Before—BUFFINGTON, WOOLLEY and DAVIS, Circuit Judges.

BUFFINGTON, Circuit Judge. This case concerns cone sounding boards, and charges infringement of Patent No. 1,271,529, granted July 2, 1918, to Hopkins for an acoustic device, and No. 1,271,527, of same date to same patentee for a sound-regulating machine. On final hearing the Court below dismissed the bill, whereupon this appeal was taken. In so deciding, the Court said: "Lumiere device, Patents 986,477 and 1,036,529, is undoubtedly a complete anticipation," and whether it was right in so holding constitutes in our judgment the principal question in this case. These Hopkins patents

were involved in two cases in the Second Circuit; Lektophone vs. Sylo, 11 Fed. (2), 421, where they were held valid and infringed, and Lektophone vs. Western, where Patent No. 1,271,529 was held valid but not infringed, and Claims 29 and 30 of Patent No. 1,271,527 were adjudged invalid. In the Circuit Court of Appeals, 16 Fed. (2), 7 and 10, their validity was not passed on, the cases being determined on the issue of non-infringement. Reference to these cases precludes needless re-statement of the general subject matter.

After full consideration we have reached the conclusion that Hopkins' Patent No. 1,271,529 was not anticipated by Lumiere or others, and that his patent is valid and infringed.

Previous to the use of the now common cone sounding board, the horn was the usual mode of giving out sound. In this state of the art, Hopkins, who had a thorough musical and scientific training, took up at the request of Mr. Edison, and in his laboratory, the problem of finding out what could be done to improve the horn and was so engaged for a year or more. Without quoting at length the very interesting illuminating proof, it suffices to say that after long experiments and study with the horn to ascertain just what its troubles were, and without finding any remedy, Hopkins' attention was directed to the sound boards used in musical instruments—the piano, violin, zither, guitar type, and the like—with the results that these were all found too heavy and the minimum energy, which alone could be utilized, was dissipated in some other way than creating sound in the air. Finally "we got into paper in our seeking for lightness, paper structures, and arrived at the cone type, attempting to simply get lightness with the proper stiffness. Then we made a discovery that the cone not only gave us what would be expected of a physical structure having lightness and thickness, but that it was a peculiarly formed thing for producing the very effect we were after. I

say that was unexpected. * * * We found that it was a direct acting sound-board surface of conical form which is very stiff around its apex and had a gradual lessening of that stiffness toward the edge. Now, we mounted that in a support which would permit it to do all of its vibrating in producing the sound and at the same time keep it in the position that it was intended to be and prevent the flimsier portions of the cone near the edges from breaking up or fluttering when we applied a reasonable amount of energy to it." The proofs satisfy us that the device of Hopkins was not a mere adaptation of existing contrivances, but came as an unexpected surprise at the end of earnest study of the subtle problems involved in this art. Of course, Hopkins is charged with notice of the earlier publication by Starling and Cole, which was published in London in 1907 in the talking machine art. This showed a conical-shaped sounding board, but of such smaller size that it was considered a mere plaything and left no impress on the art. But even if its size had been increased, which in point of fact it was not, its edges would have fluttered or been subject to "weaving" which would have destroyed its efficiency when low notes were attempted to be given off. So also is he visited with notice as to the metallic sounding diaphragm used in confined space but these threw no light upon Hopkins' problem. To our minds, Hopkins was the first to make the combination of a conical-shaped paper device of proper size, provided with flexible edges coupled to a rigid frame used in free air. All of these three elements in free air, the light conical sounding board of specified area, the flexible edge and the rigid frame, combine to reproduce pure low notes. The device has come into general use, and its licensees are now supplying the public needs.

As we understand the action of the cone in free air, waves of different frequency are shed or emitted from the cone at various zones; that is to say, all the high

frequency waves pass off into the open air near the apex of the cone, and as the waves become of lower frequency they will not pass off except from the farther out edges of the cone. In order, therefore, to send out these waves of low frequency the volume of sound must be increased, with the result that as these low frequency waves are emitted near the outer edges of the cone its edges begin to weave or flutter, and set up an independent motion of their own. This is termed blasting and is highly objectionable. Now it seems to us that Hopkins was the first to point out that this blasting effect caused by the local vibrations at the edge of the cone would be prevented and the cone held restricted to vibrations as a whole and the weaving prevented by the expedient of using a rigid frame and making a liaison between the edges of the cone and the clamp of the rigid frame by a flexible yielding liaison belt which vented and thereby prevented the obnoxious fluttering of a cone's edges not rigidly held. By these means the cone was kept in place and by reason of the flexible character of the liaison connection or belt the cone vibrated as a whole, and its outer edges did not vibrate locally. In this way the use of the added sound volume, which was necessary to carry low frequency tones to the outer edge of the cone and there allow them to pass directly into the open or unconfined air, was made possible. Such being Hopkins' disclosure, we next turn to the basic question on which the Court below decided the case, namely, whether Hopkins' disclosure was anticipated by Lumiere in his patents Nos. 986,477 and 1,036,529 of 1912. It is a significant fact that although Lumiere's device was adopted by such a strong company as the Victor, it has never passed into approving public use, and that company itself is using a cone which the General Electric Company makes as licensee under Hopkins' patent. But apart from Lumiere's patents having attained no position in the practical art, it is quite clear that he had no conception of that

which constituted the gist of Hopkins' invention. Indeed, it seems to us that on final analysis Lumiere had in reality merely a flat sounding board. It is true he used paper and has a construction which may be likened in some sense to a cone, but it seems to us the real plane of Lumiere is the central zone of his paper, for while there is an edge around the apex made by the foldings or corrugations of his paper, and it can therefore be said that he has an outer edge of a dished or quasi-conical shape, it is to be observed that there is a corresponding corrugation structure on the other side of his central or medium zone, and that the two exterior edges of his corrugations, front and back, are not really two individual side cones but are unitary in reality and one structure and that the real plane is the median flat horizontal one midway between the exterior side corrugations. Moreover, making corrugations of this sort changes a fairly flexible plane into a relatively stiff, unyielding structure. Indeed, it would seem that his corrugations were for structural or stiffening purposes rather than for sound purposes. Moreover, the outer edge of Lumiere's paper corrugated structure is flattened and is clamped—and we venture to think as a continuation of his flat median surface—to the rigid structure which holds the cone in place. Lumiere, therefore, not having the flexible rim between his cone proper and his rigid support, his sounding board moves as a unitary structure from the edge of the restraining frame to the central part, while in Hopkins' the cone moves as a whole, unrestrained and unlimited by the rigid frame. Tested by the standard of means and the product, the art never would have had a practical sounding-board had it stopped with Lumiere. It was Hopkins who gave a successful combination which produced low, clear tones on a conical sounding-board in free air. For these reasons, we believe that the Court below fell into error, and so far as Patent No. 1,271,529 is concerned its decrees should be reversed and the cause

remanded with instructions to enter a decree holding the claims in issue valid and infringed. Briefly stated we find infringement on the part of the defendant. While the form of Hopkins' circular cone is not precisely duplicated by defendant's elongated oval board, yet in area and sound functioning, it is appropriated and reproduced. By the defendant's flexible rubber liaison member, held in place by the rigid surrounding frame, weaving and fluttering of the outer edges of the sounding-board are prevented and the device as a whole produces the low, clear tones of the Hopkins device. Having thus appropriated in substance Hopkins' board and produced thereby the sounds desired, the defendant seeks to escape infringement by placing over the functioning structure an ornamental hood and thereby, as it contends, make the apparatus operate in confined air. The purpose of the hood to escape infringement by using an outward and visible form to escape an inner and duplicating substance is too clear to find lodgment in the minds of those who judge rights on the basis of substance rather than form. As to Patent No. 1,271,527, we are in accord with the views of Judge Thacher in Lektophone vs. Western, supra, which was adopted by the Court below. In that respect the decree below will be affirmed. The costs here and in the Court below will be apportioned four-fifths in favor of plaintiff and one-fifth for defendant.